

Robert D. Becker (CA Bar No. 160648)
Rbecker@manatt.com
MANATT, PHELPS & PHILLIPS, LLP
350 Cambridge Ave., Suite 300
Palo Alto, CA 94306
Telephone: (650) 812-1300
Facsimile: (650) 213-0260

Attorneys for Plaintiff,
CAPELLA PHOTONICS, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

CAPELLA PHOTONICS, INC.,
Plaintiff,
v.
CISCO SYSTEMS, INC.,
Defendant.

No. 3:14-CV-03348-EMC

**DECLARATION OF ROBERT D. BECKER
IN SUPPORT OF PLAINTIFF'S REQUEST
TO MAINTAIN CURRENT STAY ON
ACTION OR, IN THE ALTERNATIVE,
LEAVE TO AMEND INFRINGEMENT
CONTENTIONS, AND NOTICE OF
INFRINGEMENT OF ADDITIONAL
DEPENDENT CLAIMS**

**Hearing Date: March 7, 2019
Time: 1:30 p.m.
Courtroom: 5
Judge: Hon. Edward M. Chen**

CAPELLA PHOTONICS, INC.,
Plaintiff,
v.
FUJITSU NETWORK
COMMUNICATIONS, INC.,
Defendant.

No. 3:14-CV-03349-EMC
(related case)

1 CAPELLA PHOTONICS, INC.,
2 Plaintiff,

3 v.

4 TELLABS OPERATIONS, INC. AND
5 CORIANT (USA) INC.,
6
7 Defendant.

No. 3:14-CV-03350-EMC
(related case)

8 CAPELLA PHOTONICS, INC.,
9 Plaintiff,

10 v.

11 CIENA CORPORATION,
12
13 Defendant.

No. 3:14-CV-03351-EMC
(related case)

14
15 I, Robert D. Becker, hereby declare under penalty of perjury and pursuant to 28 U.S.C.
16 § 1746, as follows:

17 1. I am a partner at Manatt, Phelps & Phillips, LL and represent Plaintiff, Capella
18 Photonics, Inc. (“Capella”), in the above-captioned case.

19 2. The statements made herein are based on my personal knowledge or based on
20 information made known to me and are true and correct and to the best of my current
21 knowledge.

22 3. In this Declaration, I use the term “Defendants” to refer collectively to
23 Defendants Cisco Systems, Inc. (“Cisco”), Ciena Corporation (“Ciena”), Fujitsu Network
24 Communications, Inc. (“FNC”), Coriant Operations, Inc. (formerly Tellabs Operations, Inc.),
25 and Coriant (USA) Inc.

26 4. Capella is the owner of two patents on optical switching devices: U.S. Patent
27 RE42,368 (the “’368 Patent”) entitled “Reconfigurable Optical Add-drop Multiplexers with
28 Servo Control and Dynamic Spectral Power Management Capabilities” and U.S. Patent

1 RE42,678 (the “’678 Patent”) entitled “Reconfigurable Optical Add-drop Multiplexers with
 2 Servo Control and Dynamic Spectral Power Management Capabilities” (collectively the
 3 “Patents-in-Suit”). True and correct copies of the ‘368 Patent and ‘678 Patent are attached
 4 hereto respectively as **Exhibit A** and **Exhibit B**.

5 5. Capella filed this patent infringement action in February 2014 in the Southern
 6 District of Florida. Almost immediately thereafter, Capella filed infringement contentions in
 7 April 2014 as order by the Florida Court. A true and correct copy of Capella’s infringement
 8 contentions against all defendant’s is attached hereto as **Exhibit C**.

9 6. In its Preliminary Infringement Contentions, Capella asserted that the Defendants
 10 infringed [19] of the 22 claims in the ‘368 Patent (claims 1-6, 9-12, 15-22) and [24] of the 67
 11 claims in the ‘678 Patent (claims 1-4, 9, 10, 13, 17, 19-23, 27, 29, 44-46, 53, 61-65).

12 7. On July 15, 2014, Cisco filed a petition at the Patent and Trademark Office for
 13 *inter partes* review (“IPR”) (IPR2014-01166) on the ‘368 patent. Cisco filed an IPR petition
 14 (IPR2014-01276) on the ‘678 patent less than a month later. After the other Defendants filed
 15 similar IPR Petitions, the PTO joined Ciena, FNC, and Coriant in these two IPR proceedings
 16 (the “IPR Proceedings”).

17 8. The Defendants’ Petitions in the IPR Proceedings challenged only those claims
 18 identified by Capella in its Preliminary Infringement Contentions. As noted above, however,
 19 the Patents-in-Suit contain additional claims not identified in Capella’s Preliminary
 20 Infringement Contentions. The Defendants made the strategic decision in their IPR Petitions
 21 not to challenge all claims in the Patents-in-Suit.

22 8. In August 2015, the PTO instituted *inter partes* review on several of the
 23 Defendants’ Petitions involving the Patents-in-Suit. Between January 2016 and October 2016
 24 the PTO issued Final Written Decisions on the Defendants’ IPRs. In those Final Decisions, the
 25 PTO found unpatentable each claim identified by Capella in its Preliminary Infringement
 26 Contentions. After Capella appealed, the Federal Circuit affirmed the PTO’s Final Written
 27 Decisions in February 2018. True and correct copies of the Final Decisions in the IPR
 28 Proceedings on the ‘368 Patent and ‘678 Patent are attached hereto respectively as **Exhibit D**

1 and **Exhibit E**. Capella exhausted its appeals in November 2018, when the U.S. Supreme Court
2 denied its Petition for Writ of Certiorari.

3 9. The ‘368 and ‘678 claims have been amended in Resissue Application
4 (discussed below) to merely clarify that the claimed fiber collimators serve as ports. During
5 the IPR proceedings, under the broader BRI claim construction standard employed by the
6 PTAB at that time, the PTAB found that the claims were not so limited and found them
7 unpatentable in view of the prior art. Capella did not anticipate and could not reasonably have
8 anticipated this broad claim construction at the time it filed its Preliminary Infringement
9 Contentions and no party included these claim constructions in their Markman papers. In their
10 Joint Claim Construction and Prehearing Statement (Dkt. # 151) the parties jointly identified
11 “Channel micromirror” for construction. Capella asserted that no term other than “channel
12 micromirror” requires construction and that all other terms should be awarded their plain and
13 ordinary meaning. The Defendants identified the following additional terms for construction:
14 “Continuously”; “Controllable in two dimensions/Controlling . . . in two dimensions”;
15 “Corresponding”; “Beam-deflecting element(s)”; “Elements being individually...
16 controllable”; “Maintaining a predetermined coupling”; and “Servo-control assembly”.
17 Capella asserts that this issue would not have surfaced in these district court proceedings as
18 the district court is not able to use the BRI standard then employed by the PTAB.

19 10. Based on the PTO’s construction of the claims, Capella filed with the PTO on
20 June 29, 2018 applications pursuant to 35 U.S.C. § 251 to reissue both the ‘368 Patent and the
21 ‘678 Patent (the “Reissuance Applications”). True and correct copies of the Reissuance
22 Applications for the ‘368 Patent and ‘678 Patent are attached hereto respectively as **Exhibit F**
23 and **Exhibit G**.

24 11. On December 10, 2018, the PTO issued IPR certificates cancelling claims 1-6,
25 9-13 and 15-22 of the ‘368 Patent and claims 1-4, 9, 10, 13, 17, 19-23, 27, 29, 44-46, 53 and
26 61-65 of the ‘678 Patent. True and correct copies of the IPR certificates for the ‘368 Patent and
27 ‘678 Patent are attached hereto respectively as **Exhibit H** and **Exhibit I**.
28

1 12. Attached hereto as **Exhibit J** is a copy of 83 Fed.Reg. 197 (Oct. 11, 2018 (to be
2 codified as 37 C.F.R, Part 42.

3 13. Attached hereto as **Exhibit K** is a copy of Capella's proposed First Amended
4 Infringement Contentions against all Defendants.

5
6 Dated: February 14, 2019

MANATT, PHELPS, & PHILLIPS, LLP

7 By: /s/ Robert D. Becker
8 Robert D. Becker
9 Attorneys for Plaintiff
10 *Capella Photonics, Inc.*
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CERTIFICATE OF SERVICE

I hereby certify that on February 14, 2019, I served the foregoing with the Clerk of Court using the CM/ECF system which will automatically send email notification of such filing to the attorneys of record.

/s/ Robert D. Becker
Robert D. Becker

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